

### REMARKS

Reconsideration and allowance are respectfully requested.

Claims 1-16 are pending.

The Office Action Summary acknowledged the claim for foreign priority, but alleged that none of the certified copies of the priority documents have been received. This is incorrect as shown by the attached. In the parent Application No. 09/958,928, the copies of the Office Action Summary mailed October 3, 2003 and the Notice of Allowability mailed March 25, 2004 both confirm that all certified copies of the priority documents have been received in the U.S. national-stage application from the International Bureau. Therefore, Applicants request that acknowledgement of the receipt of the certified copy of priority document JP 2000-40218 be made in the next Official communication.

#### *35 U.S.C. 112 – First Paragraph*

The specification must convey with reasonable clarity to persons skilled in the art that applicant was in possession of the claimed invention as of the filing date sought. See *Vas-Cath v. Mahurkar*, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). But the Patent Office has the initial burden of presenting evidence or a reason why persons of ordinary skill in the art would not have recognized such a description of the claimed invention in the original disclosure. See *In re Gosteli*, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

Claims 1-16 were rejected under Section 112, first paragraph, “as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” Applicants traverse.

The FERMBP-7434 strain recited in the claims was deposited under the terms of the Budapest Treaty. A copy of the depository receipt is attached. Access to the deposit will be available during pendency of the patent application making reference to the deposit to one determined by the Director to be entitled thereto. Subject to 37 CFR § 1.808(b), all restrictions imposed by the depositor on the availability to the public of the deposit will be irrevocably removed upon granting of a patent; the deposit will be

maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer; and the deposit will be replaced if it should ever become inviable.

Withdrawal of the Section 112, first paragraph, rejection is requested.

### *Double Patenting*

Claims 1-16 were rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1-10 of U.S. Patent No. 6,797,279. Applicants traverse since a terminal disclaimer was submitted on September 11, 2006.

It should be noted that the filing of a terminal disclaimer to overcome a rejection based on non-statutory double patenting is not an admission that the rejection was proper. See *Quad Environmental Technologies Corp. v. Union Sanitary District*, 20 USPQ2d 1392, 1394-95 (Fed. Cir. 1991). The Court stated that the “filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.” Thus, submission of a terminal disclaimer is not an admission that the pending claims are obvious over the claims of U.S. Patent No. 6,797,279.

Withdrawal of the double patenting rejection is requested.

### *Conclusion*

Finally, it was erroneously stated, “All claims fail to be patentably distinguishable over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449” on page 6 of the Action. But no prior art was discussed in this Action in such a way as to reject original claims 1-16 under Sections 102 and/or 103. This statement appears to be an inadvertent error by the Examiner and if maintained in the next Action, Applicants request clarification of the “art” rejection and the opportunity to respond fully prior to that rejection being made final.

Having fully responded to all of the pending objections and rejections contained in this Office Action, Applicants submit that the claims are in condition for allowance and

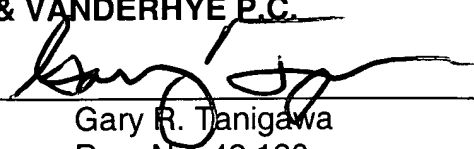
TODA et al. – Appln. No. 10/784,209

earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_

  
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特許手続上の微生物の寄託の国際的承認  
に関するブダペスト条約

BUDAPEST TREATY ON THE INTERNATIONAL  
RECOGNITION OF THE DEPOSIT OF  
MICROORGANISMS FOR THE PURPOSES OF  
PATENT PROCEDURE

RECEIPT IN THE CASE OF AN ORIGINAL  
DEPOSIT

下記国際寄託当局によって規則 7. 1 に従い  
発行される。

issued pursuant to Rule 7.1 by the  
INTERNATIONAL DEPOSITARY AUTHORITY  
identified at the bottom of this  
page.

### 原寄託についての受託証

氏名 (名称)

バイオケム工業株式会社  
代表取締役社長 戸田 順博

寄託者

あ て 名 義

殿

神戸市兵庫区和田山通1丁目2-25-D4  
07

#### 1. 微生物の表示

(寄託者が付した識別のための表示)  
TFK-RC-99

(受託番号)  
FERM BP- 7434

#### 2. 科学的性質及び分類学上の位置

1 欄の微生物には、次の事項を記載した文書が添付されていた。

- 科学的性質
- 分類学上の位置

#### 3. 受領及び受託

本国際寄託当局は、平成 11 年 11 月 18 日 (原寄託日) に受領した 1 欄の微生物を受託する。

#### 4. 移管請求の受領

本国際寄託当局は、平成 11 年 11 月 18 日 (原寄託日) に 1 欄の微生物を受領した。  
そして、平成 13 年 1 月 18 日に原寄託よりブダペスト条約に基づく寄託への移管請求を受領した。  
(平成 11 年 11 月 18 日に寄託された微生物寄託番号 P- 17654 号より移管)

#### 5. 国際寄託当局

経済産業省産業技術総合研究所生命工学工業技術研究所

名称: National Institute of Advanced Industrial Science and Technology

所長 大審 信

Dr. Shinobu Ohtsuka Director-General

あて名: 日本国茨城県つくば市東1丁目1番3号 (郵便番号 305-8566)  
1-3, Higashi 1 chome Tsukuba-shi Ibaraki-ken  
305-8566, JAPAN

平成13年(2001) 1月18日



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/958,928	01/03/2002	Nobuhiko Toda	1035-345	6726

7590 10/03/2003  
Nixon & Vanderhye  
1100 North Glebe Road 8th Floor  
Arlington, VA 22201-4714

EXAMINER

WARE, DEBORAH K

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**COPY**

# Office Action Summary

Application No.

09/958,928

Applicant(s)

TODA ET AL.

Examiner

Deborah K. Ware

Art Unit

1651

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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NOTICE OF ALLOWANCE AND FEE(S) DUE

23117 7590 03/25/2004

NIXON & VANDERHYTE, PC  
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ARLINGTON, VA 22201-4714

**COPY**

EXAMINER	
WARE, DEBORAH K	
ART UNIT	PAPER NUMBER

1651

DATE MAILED: 03/25/2004

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/958,928	01/03/2002	Nobuhito Toda	1035-345	6726

TITLE OF INVENTION: RHODOPSEUDOMONAS CAPSULATAS STRAIN NO. FERM BP-7434 FOR USE IN HEALTH FOODS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$665	\$300	\$965	06/25/2004

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status is changed, pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above and notify the United States Patent and Trademark Office of the change in status, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

☐ Applicant claims SMALL ENTITY status.  
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

<b>Notice of Allowability</b>	Application No.	Applicant(s)	
	09/958,928	TODA ET AL.	
	Examiner	Art Unit	
	Deborah K. Ware	1651	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

**COPY**

1. ☒ This communication is responsive to \_\_\_\_\_.
2. ☒ The allowed claim(s) is/are 1, 2, 6-8 and 11-15.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.34(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                       |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                               |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance                         |
|   | 9. <input type="checkbox"/> Other _____.  |